

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

AUG 28 2003

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AMIR WEINBERG
and ERAN LESHEM

Application No. 09/315,795

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on August 11, 2003. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

A review of the application reveals that there are numerous discrepancies within the application that do not put this application in proper condition for appeal. The Board notes the following discrepancies:

(a) An Information Disclosure Statement (IDS) was filed on January 6, 2000 (Paper No. 8). It is not clear from the record whether the examiner considered the statement submitted or

whether the examiner notified appellants of why their submission did not meet the criteria set forth in 37 CFR §§ 1.97 and 1.98;

(b) In the Examiner's Answer mailed on April 4, 2003 (Paper No. 20), the examiner discusses the Fifth International World Wide Web Conference on May 6-10, 1996, Paris, France in his grounds of rejection, but does not rely upon this conference as prior art in his rejection of claims on appeal; and

(c) A further review of the Examiner's Answer (Paper No. 20) reveals that there is no evidence that an appeals conference was conducted by the examiner. According to the Manual of Patent Examining Procedure (MPEP) §. 1208 (8th ed., rev. 1, Feb. 2003):

[T]he word 'Conferees:' should be included, followed by the typed or printed names of the other two appeal conference participants. These two appeal conference participants must place their initials next to their name. This will make the record clear that an appeal conference has been held.

Accordingly, it is

ORDERED that the application is returned to the examiner for resolution of the following issues:

(1) for consideration of the IDS filed January 6, 2000 (Paper No. 8), and notification to appellants in writing of consideration;

(2) for clarification regarding the Fifth International World Wide Web Conference as prior art, and notification to appellants of such;

Application No. 09/315,795

(3) for taking corrective action regarding the appeals conference; and

(4) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: 

DALE M. SHAW

Program and Resource Administrator
(703) 308-9797

cc: Knobbe, Martens, Olson & Bear LLP
2040 Main Street
Fourteenth Floor
Irvine, CA 92614

DMS/clm/meh
RA03-0513